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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 65187-179 | |
|---|------------------------------------|---------------------------------------|--|
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____ | Application Number 09/597,016 | Filed 06/20/2000 | |
| | First Named Inventor Liang Hong | | |
| | Art Unit 2617 | Examiner Nghi H Ly | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35,859</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number _____</p> <p><i>Michael J. Donohue</i> _____ Signature <u>Michael J. Donohue</u> _____ Typed or printed name <u>206-628-7640</u> _____ Telephone number <u>August 25, 2006</u> _____ Date</p> | | | |
| <input type="checkbox"/> *Total of _____ forms are submitted. | | | |

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal review for the following reasons:

1. The Examiner has not established a *prima facie* case of obviousness to support the combination of references asserted in the Office Action; and
2. the Examiner has made factual errors in interpretation of the references.

AN OBVIOUSNESS REJECTION CANNOT BE ASSERTED WHEN THERE IS NO PRIMA FACIE CASE OF OBVIOUSNESS ESTABLISHED BY THE EXAMINER.

The Examiner has rejected each claim on the basis of the combined teachings of two or more references. Independent claims 1 and 9 are rejected over the combination of U.S. Patent No. 6,301,514 to Canada, U.S. Patent No. 5,289,160 to Fiorletta, and U.S. Patent No. 6,88,586 to Pearson.

As discussed in detail in the amendment of April 25, 2006, the Examiner has the burden of establishing a *prima facie* case of obviousness based on the prior art. It is also a well settled rule of law that there must be some motivation, suggestion, or teaching of the desirability of making a specific combination in that teachings of references can be combined only if there is some suggestion or incentive to do so. The need for specificity is critical and particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the matter claimed.

In the present case, the Examiner combines multiple references from unrelated technologies and provides no reasonable basis for the combination. As noted in the amendment of 04/25/2006, it is impermissible to break an invention down into its components parts (A + B + C) and then finding a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. *Ruiz v. A.B. Chance Co.*, 69 USPQ 2d 1686, 1690 (Fed. Cir. 2004).

In the present case, the Examiner has used impermissible piecemeal analysis with respect to at least claims 1 and 9. It is noted that the Office Action uses three separate references to reject portions of claims 1 and 9, but provides no

motivation for combining the references and, therefore, does not consider the claim as a whole, as required by law.

The References are from Unrelated Technologies.

The applicants noted, in the response dated 04/25/2006, at page 11, that the Examiner has used applicants' pending patent application as template to piece together references that do not lend themselves to the asserted combination. The applicants further note, at pages 9-10, that each of the three references (*i.e.*, Canada, Fiorletta, and Pearson) are classified in totally different U.S. classifications and completely different fields of search. The applicants believe that the only suggestion for the combination of references lies in the pending claims. The Examiner has impermissibly used the claims as a roadmap to find three disparate references that each contain a minor shred of the combination recited in, by way of example, claim 1. Furthermore, there are no overlapping classifications or fields of search between Canada, Fiorletta, Pearson, or Patel. (See Response dated 04/25/2006, at page 12.) The applicants requested that the Examiner provide objectively verifiable evidence to support the combination of multiple references.

In light of the fact that most references are not even contained within the same U.S. classification or field of search, there is no motivation to combine the references, and the Examiner has not provided any objective evidence to support the combination. Thus, the Examiner has failed to establish a *prima facie* case of obviousness. For at least this reason, the claims are allowable over the combination of references.

There is No Motivation or Suggestion to Combine the References.

In the Office Action dated 01/26/2006, at page 3, the Examiner asserted that it would have been obvious to combine Fiorletta and Canada "to warn a driver of a vehicle low pressure in one or more of its tires so that the driver may take corrective action before a tire blowout occurs." The same Office Action states, at page 4, that it would be obvious to provide the teaching of Pearson into the system of Canada and

Fiorletta “to provide non-volatile storage of a partial program within each wireless subscriber terminal so that the wireless subscriber terminal need not receive an entire program in a single session.”

In a response dated 04/25/2006, the applicants stated, at pages 9-11, that the Examiner provides a motivation for Fiorletta to create the invention of Fiorletta and for Pearson to create the invention of Pearson. However, the Examiner provides no motivation for combination of the references.

The applicants requested the Examiner to point to objectively verifiable evidence in any of the references (*i.e.*, Canada, Fiorletta, or Pearson) that suggested the combination. (See Response dated 04/25/2006, page 11.) In the final Office, the Examiner generally states that the references “teach wireless communication and polling.” (See Office Action dated 07/13/2006, page 2.) This is a mischaracterization of the references as several references are not related to either wireless communication or polling.

The Examiner further states the motivation in Fiorletta is “to warn a driver of a vehicle low pressure in one or more of its tires so that the driver may take corrective action before a tire blows out (see Fiorletta, Abstract) *and* in order to provide non-volatile storage of a partial program within in each wireless subscriber terminal so that the wireless subscriber terminal need not receive an entire program in a single session (see Pearson, Abstract) *and* in order to enable a caller to contact a system subscriber at any location (see Patel, column 1, lines 1-12) *and* in order to provide a method and device for communication in traffic guidance systems and that the data and voice channels reserve for traffic operation can be better utilized (see Gehrig, column 2, lines 25-31) *and* in order to provide a system for the wireless transmission of multiple information signals utilizing digital time division circuits between a base station and subscriber stations (see Paneth, column 1, lines 20-23) *and* in order to prevent collision (see Serikawa, column 36, lines 49-58) *and* in order to prevent unauthorized usage of device *and* in order to provide a system for communication efficiency and minimizing the effect of multipath interference (see Jandrell, Abstract).” (See Office Action dated 07/13/2006, page 3-4.)

It should be noted that in each case, the Examiner describes a motivation for the respective inventors to create each of their respective inventions. Nothing in these references suggests the combination with other references to achieve the claimed invention. Thus, the Examiner had failed to establish a *prima facie* case of obviousness.

THE EXAMINER HAS MADE FACTUAL ERRORS IN THE INTERPRETATION OF THE REFERENCES.

In a rejection of claim 13, the Examiner asserts that Serikawa “teaches tearing down a traffic channel used by the transceiver unit in response to detecting (see column 36, lines 49-58 and see column 19, lines 17 to column 20, line 1.” (See Office Actions of 01/26/2006, page 7 and 07/13/2006, page 10.) The sections of Serikawa cited by the Examiner do not describe tearing down of a data traffic channel generally, and, more specifically, do not describe tearing down a data traffic channel “after detecting the communication failure,” as recited in claim 13. The Examiner has ignored the fact that the process of tearing down a communication channel occurs after detecting a communication failure and merely cites Serikawa as teaching tearing down a traffic channel in response to “detecting.” The Office Action provides no details as to what is being detected.

In addition, the Examiner has mischaracterized the applicants’ remarks in an amendment dated 07/22/2004 (see Office Action of 01/26/2006, page 7 and 07/13/2006, page 10.) The Examiner appears to cite the applicants’ admission of the teachings of Serikawa, but the amendment of 07/22/2004 makes no such statement. The applicants addressed this issue in the amendment of 04/25/2006 (see page 15), but the applicants’ subsequent arguments were ignored by the Examiner.

In rejecting claims 22-25, the Examiner cites a combination of Canada and Gehrig. (See Office Action 01/26/2006, pages 9-10.) The applicants note that the Examiner has mischaracterized Gehrig in the amendment dated 04/25/2006 (see pages 17-18). The Examiner ignored the applicants’ remarks and again mischaracterized Gehrig in the Office Action dated 07/13/2006 (see page 13).

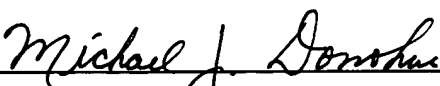
SUMMARY

The Examiner has impermissibly used the claims as a roadmap to find multiple references that contain bits and pieces that have been stitched together by the Examiner as a basis for rejecting the pending claims. The references are from disparate technologies and are classified in different areas by the U.S. Patent Office. The Examiner provides no motivation for combining the multiple references to achieve the claimed invention. In the absence of such motivation, the Examiner has not established a *prima facie* case of obviousness. For this reason, the pending claims should be allowed.

Furthermore, the Examiner has mischaracterized references and has ignored the applicants' remarks that point out the mischaracterization. When the teachings of references are considered as a whole, the pending claims are allowable over the various combinations of references.

The applicants respectfully request a reversal of the rejection and the allowance of the pending claims.

Respectfully submitted,
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